

Remarks

The Office Action mailed July 16, 2003 and made final, and the Advisory Action mailed December 5, 2003 have been carefully reviewed and the following remarks have been submitted in consequence thereof.

Applicants and the undersigned wish to express their appreciation to the Examiner for the courtesies she extended during a telephone interview that occurred on about December 24, 2003. The undersigned contacted the Examiner for an explanation of the comments provided in the Advisory Action dated December 5, 2003. More specifically, the undersigned requested an explanation as to the suggestion included in the Advisory Action that the presently pending claims include "nonfunctional descriptive material". Although no agreement was reached with respect to the patentability of the claims, the Examiner indicated that she had a better understanding of the invention following the telephone interview and suggested only minor "syntax" changes to the claims to address her "nonfunctional descriptive material" objection. Although Applicants traversed the suggestion included in the Advisory Action that the pending claims included "nonfunctional descriptive material", the claims have been amended to incorporate the minor "syntax" changes. Accordingly, the foregoing amendment has been made in consequence of the Examiner Interview.

Accordingly, Applicants respectfully submit that the present patent application is in condition for allowance.

Claims 1-8, 10-43, and 45-67 are pending in this application. Claims 1-8, 10-43, and 45-67 stand rejected. Claims 9 and 44 have been cancelled.

In accordance with 37 C.F.R. 1.136(a), a three-month extension of time is submitted herewith to extend the due date of the response to the Office Action dated July 16, 2003, and made final, and the Advisory Action dated December 5, 2003 for the above-identified patent application from October 16, 2003 through and including January 16, 2004. An extension of one-month has already been secured. The fee paid therefore of \$110.00 is deducted from the total fee due for the total months of extension now requested. Authorization to charge a deposit

account in the amount of \$840.00 to cover this extension of time request also is submitted herewith.

The rejection of Claims 1-8, 10, 14, 16, 21, 22, 33-38, 40-43, 46, 49, 57, 64, 65, 66, and 67 under 35 U.S.C. § 103(a) as being unpatentable over Eder (U.S. Patent No. 6,393,406) in view of Luchs et al. (U.S. Patent No. 4,831,526) (Luchs) is respectfully traversed.

Applicants respectfully submit that neither Eder nor Luchs, considered alone or in combination, describe or suggest the claimed invention. As discussed below, at least one of the differences between the cited references and the present invention is that neither Eder nor Luchs, alone or in combination, describe or suggest a method for providing a value of a good to a requester that includes using a computer to determine whether the value of the good can be calculated based on the uploaded data including determining whether the good has a policy value assigned thereto, designating the request for the value of the good as an exception request if no response is provided by the computer to the request for the value of the good, analyzing trends among a plurality of similar exception requests, and inputting at least one new policy value for a good based on the exception request analysis.

More specifically, Applicants respectfully submit that neither Eder nor Luchs, considered alone or in combination, describe or suggest a method for providing a value of a good to a requester that includes analyzing trends among a plurality of similar exception requests, and inputting at least one new policy value for a good based on the exception request analysis.

Moreover, Applicants respectfully submit that Luchs is non-analogous art that is not relevant to the present patent application. Luchs describes a computerized insurance system for processing and preparing applications for insurance and premium quotations and for preparing and writing insurance contracts. Although Luchs discusses calculating insurance premiums for a potential customer, Luchs does not address issues related to providing a value of a good to a requester or determining whether the value of a good can be calculated based on uploaded data. Given the obvious differences between processing and preparing insurance applications and determining whether a value of a good can be calculated based on uploaded data, and the fact that the insurance system described by Luchs neither recognizes nor solves any problems

addressed by the present invention, it is respectfully submitted that Luchs is non-analogous art that would not be looked to for potential solutions in valuing an asset.

Furthermore, Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. Obviousness cannot be established by merely suggesting that it would have been obvious to one of ordinary skill in the art to modify Eder according to the teachings of Luchs. More specifically, as is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. Neither Eder nor Luchs, considered alone or in combination, describe or suggest the claimed combination. Rather, the present Section 103 rejection is based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention.

The Office Action suggests at page 3 that the “motivation to combine these references is Eder’s valuation model is used to value businesses and equipment for insurance coverage purposes as well as to determine the equity prices...stock price of a business as a measure of value and risk is the appraisal that backs up the amount and type of insurance the company sells and the policy’s price.” Applicants respectfully submit that Eder provides no support for the statement that Eder’s valuation model is used to value businesses and equipment for insurance purposes. In fact, Eder does not even mention the word “insurance”. Rather, Eder is directed at valuing elements of a high technology commercial enterprise where a significant portion of the business value is associated with intangible assets (see col. 4, lines 15-18). Intangible assets are assets not typically covered by insurance. Accordingly, there is no motivation to combine Eder with Luchs.

Since there is no teaching nor suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection be withdrawn.

Eder describes a system and method for measuring performance of elements of value of a business enterprise (see Abstract). An element of value is defined as “an identifiable entity or group that as a result of past transactions has provided and is expected to provide economic benefit to the enterprise” (see column 9, line 65- column 10, line 2). An example of an element of value is a sales staff of the enterprise (see column 10, lines 3-5). According to Eder, valuation of the enterprise is completed in six distinct stages (see column 10, lines 23-25) which include: extracting, aggregating and storing data from user input, existing internal databases (10, 15, 30, 35 or 40) and external databases (5) (first stage 200); calculating composite variables that characterize performance of the elements of value (second stage 300); calculating revenue, expense and capital value components (third stage 400); specifying and optimizing predictive models to determine relationship between the elements of value and the revenue, expense and capital values (fourth stage 500); combining the results of the third and fourth stages to determine the value of each element (fifth stage 600); and determining relationship between equity and calculated total value (sixth stage 700) (see column 10, lines 24-50).

Luchs describes a computerized insurance system for processing and preparing applications for insurance and premium quotations and for preparing and writing insurance contracts. The system has a central processor, including a data bank into which data is written and from which data is read. The data includes information regarding the risk to be insured, client information, insurance premium information and predetermined text data for incorporation with insurance contracts. The central processor is interconnected with plural terminals, including input and display apparatus, to permit data to be entered and retrieved from the central processor. The central processor is also provided with the capability of merging entered or stored data with predetermined text data to compile data embodying a final insurance document. This data is then communicated to a printer for printing of the insurance document.

Claim 1 recites a method for providing a value of a good to a requester, the method including the steps of “storing in a database a plurality of goods including a description of each good...assigning a policy value to at least one good stored in the database...uploading data to a computer including a request for a value of a good and data relating to the good, the computer configured as a calculator for calculating a value of the good...using the computer to determine whether the value of the good can be calculated based on the uploaded data including

determining whether the good has a policy value assigned thereto...designating the request for the value of the good as an exception request if no response is provided by the computer to the request for the value of the good...analyzing trends among a plurality of similar exception requests...inputting at least one new policy value for a good based on the exception request analysis...calculating the value of the good...and displaying the value of the good.”

Neither Eder nor Luchs, considered alone or in combination, describe or suggest a method for providing a value of a good to a requester that includes using a computer to determine whether the value of the good can be calculated based on the uploaded data including determining whether the good has a policy value assigned thereto, designating the request for the value of the good as an exception request if no response is provided to the request for the value of the good, analyzing trends among a plurality of similar exception requests, and inputting at least one new policy value for a good based on the exception request analysis.

More specifically, neither Eder nor Luchs, considered alone or in combination, describe or suggest a method for providing a value of a good to a requester that includes analyzing trends among a plurality of similar exception requests, and inputting at least one new policy value for a good based on the exception request analysis.

Rather, in contrast to the present invention, Eder describes a system for measuring the performance of elements of a business enterprise and for valuing the elements on a specified valuation date, wherein the performance of the elements is calculated using composite variables, and wherein predictive models are used to determine the correlation between the element performance and the enterprise value drivers, revenue, expenses, and changes in capital; and Luchs describes a computerized insurance system for processing and preparing applications for insurance and premium quotations and for preparing and writing insurance contracts.

As acknowledged by the Office Action at pages 2-3, Eder does not disclose “determining whether the value of the good can be calculated based on the uploaded data including determining whether the good has a policy value assigned thereto, recognizing the request for the value of the good as an exception request if no response is provided to the request for the value

of the good, analyzing trends among a plurality of exception requests, inputting at least one new policy value for a good based on the exception request analysis.”

Moreover, although the Office Action suggests at page 3 that Luchs discloses “customized insurance quotes based on non-standard factors and review of those exception insurance quotes for trend analysis”, Luchs does not describe nor suggest a method for providing a value of a good to a requester that includes using a computer to determine whether the value of the good can be calculated based on the uploaded data including determining whether the good has a policy value assigned thereto, designating the request for the value of the good as an exception request if no response is provided to the request for the value of the good, analyzing trends among a plurality of similar exception requests, and inputting at least one new policy value for a good based on the exception request analysis. In fact, the Office Action fails to even suggest that Luchs teaches any of the recitations included within Claim 1. Accordingly, Applicants respectfully submit that Claim 1 is patentable over Eder in view of Luchs.

For at least the reasons set forth above, Applicants respectfully submit that Claim 1 is patentable over Eder in view of Luchs.

Claims 2-8, 10, 14, 16, 21, 22, and 33 depend, directly or indirectly, from independent Claim 1 which is submitted to be in condition for allowance. When the recitations of Claims 2-8, 10, 14, 16, 21, 22, and 33 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2-8, 10, 14, 16, 21, 22, and 33 are also patentable over Eder in view of Luchs.

Claim 34 recites a system for providing a value of a good to a requester that includes “at least one computer...a database for storing a plurality of goods including a description of each good and whether a policy value has been assigned to the good...a server coupled to said database and configured to read input data including a request for a value of the good and data relating to the good, said server further configured to determine whether the value of the good can be calculated based on the inputted data including determining whether the good has a policy value assigned thereto, recognize the request for the value of the good as an exception request if no response is provided by the system to the request for the value of the good, analyze trends

among a plurality of similar exception requests, receive at least one new policy value for a good based on the exception request analysis, and calculate the value of the good...a network connecting said server to said computer...and a user interface allowing a requester to input data relating to a request for the value of the good and data relating to the good and receive the value of the good output.”

Neither Eder nor Luchs, considered alone or in combination, describe or suggest a system for providing a value of a good to a requester that includes a server configured to determine whether the value of the good can be calculated based on inputted data including determining whether the good has a policy value assigned thereto, recognize the request for the value of the good as an exception request if no response is provided by the system to the request for the value of the good, analyze trends among a plurality of similar exception requests, receive at least one new policy value for a good based on the exception request analysis, and calculate the value of the good.

More specifically, neither Eder nor Luchs, considered alone or in combination, describe or suggest a server configured to analyze trends among a plurality of similar exception requests, and receive at least one new policy value for a good based on the exception request analysis.

Rather, in contrast to the present invention, Eder describes a system for measuring the performance of elements of a business enterprise and for valuing the elements on a specified valuation date, wherein the performance of the elements is calculated using composite variables, and wherein predictive models are used to determine the correlation between the element performance and the enterprise value drivers, revenue, expenses, and changes in capital; and Luchs describes a computerized insurance system for processing and preparing applications for insurance and premium quotations and for preparing and writing insurance contracts.

The Office Action acknowledges at pages 3 that Eder does not disclose “a server configured to read input data relating to a request for a value of the good and data relating to the good said server further configured to determine whether the value of the good can be calculated based on the inputted data including determining whether the good has a policy value assigned thereto, recognize the request for the value of the good as an exception request if no response is

provided by the system to the request for the value of the good, analyze trends among a plurality of exception requests, receive at least one new policy value for a good based on the exception request analysis.”

Moreover, although the Office Action suggests at page 3 that Luchs discloses “a central processor including a data bank into which data is written and from which data is read”, Luchs does not describe nor suggest a system for providing a value of a good to a requester that includes a server configured to determine whether the value of the good can be calculated based on inputted data including determining whether the good has a policy value assigned thereto, recognize the request for the value of the good as an exception request if no response is provided by the system to the request for the value of the good, analyze trends among a plurality of similar exception requests, receive at least one new policy value for a good based on the exception request analysis, and calculate the value of the good. In fact, the Office Action fails to even suggest that Luchs teaches any of the recitations included within Claim 34. Accordingly, Applicants respectfully submit that Claim 34 is patentable over Eder in view of Luchs.

Furthermore, the Office Action suggests at page 3 that “creating exception reports is an old and well-known strategy in the computer art.” However, Applicants respectfully submit that Claim 34 does not include a recitation directed at creating an exception report. Neither Eder nor Luchs, considered alone or in combination, describe or suggest the system recited in Claim 34. Accordingly, Applicants respectfully submit that Claim 34 is patentable over Eder in view of Luchs.

For at least the reasons set forth above, Applicants respectfully submit that Claim 34 is patentable over Eder in view of Luchs.

Claims 35-38, 40-43, 46, 49, 57, 64, and 65 depend, directly or indirectly, from independent Claim 34 which is submitted to be in condition for allowance. When the recitations of Claims 35-38, 40-43, 46, 49, 57, 64, and 65 are considered in combination with the recitations of Claim 34, Applicants submit that dependent Claims 35-38, 40-43, 46, 49, 57, 64, and 65 are also patentable over Eder in view of Luchs.

Claim 66 recites a method for providing a value of a good to a requester that includes “storing in a database a plurality of goods including a description of each good...assigning a policy value to at least one good stored in the database...uploading data to a computer including a request for a value of a good and data relating to the good, the computer configured as a calculator...using the computer to determine whether the value of the good can be calculated based on the uploaded data including determining whether the good has a policy value assigned thereto...calculating the value of the good if the value can be calculated based on the uploaded data...designating the request for the value of the good as an exception request if the value cannot be calculated based on the uploaded data and then prompting the requester to provide additional information relating to the good...researching by an analyst the value of the good based on the uploaded data and the additional information...calculating the value of the good based on the research performed by the analyst...analyzing trends among a plurality of similar exception requests...and inputting at least one new policy value for a good based on the exception request analysis.”

Neither Eder nor Luchs, considered alone or in combination, describe or suggest a method as recited in Claim 66. More specifically, neither Eder nor Luchs, considered alone or in combination, describe or suggest a method that includes designating a request for a value of a good as an exception request if the value cannot be calculated based on uploaded data and then prompting the requester to provide additional information relating to the good, researching by an analyst the value of the good based on the uploaded data and the additional information, calculating the value of the good based on the research performed by the analyst, analyzing trends among a plurality of similar exception requests, and inputting at least one new policy value for a good based on the exception request analysis.

Rather, in contrast to the present invention, Eder describes a system for measuring the performance of elements of a business enterprise and for valuing the elements on a specified valuation date; and Luchs describes a computerized insurance system for processing and preparing applications for insurance and premium quotations and for preparing and writing insurance contracts. Accordingly, Applicants respectfully submit that Claim 66 is patentable over Eder in view of Luchs.

For at least the reasons set forth above, Applicants respectfully submit that Claim 66 is patentable over Eder in view of Luchs.

Claim 67 recites a method for providing a value of a good to a requester that includes “uploading data relating to a request for a value of a good and data relating to the good to a computer configured as a calculator for calculating a value of the good...recognizing the request for the value of the good as an exception request if no response is provided to the request for the value of the good...analyzing trends among similar exception requests...and inputting a new policy value for a good based on the exception request analysis to facilitate subsequent valuations of similar goods.”

Neither Eder nor Luchs, considered alone or in combination, describe or suggest a method as recited in Claim 67. More specifically, neither Eder nor Luchs, considered alone or in combination, describe or suggest a method that includes analyzing trends among similar exception requests, and inputting a new policy value for a good based on the exception request analysis to facilitate subsequent valuations of similar goods.

Rather, in contrast to the present invention, Eder describes a system for measuring the performance of elements of a business enterprise and for valuing the elements on a specified valuation date; and Luchs describes a computerized insurance system for processing and preparing applications for insurance and premium quotations and for preparing and writing insurance contracts. Accordingly, Applicants respectfully submit that Claim 67 is patentable over Eder in view of Luchs.

For at least the reasons set forth above, Applicants respectfully submit that Claim 67 is patentable over Eder in view of Luchs.

In addition to the arguments set forth above, Applicants respectfully submit that Luchs is non-analogous art that is not relevant to the present patent application. Luchs describes a computerized insurance system for processing and preparing applications for insurance and premium quotations and for preparing and writing insurance contracts. Although Luchs discusses calculating insurance premiums for a potential customer, Luchs does not address issues related to providing a value of a good to a requester or determining whether the value of a good

can be calculated based on uploaded data. Given the obvious differences between processing and preparing insurance applications and determining whether a value of a good can be calculated based on uploaded data, and the fact that the insurance system described by Luchs neither recognizes nor solves any problems addressed by the present invention, it is respectfully submitted that Luchs is non-analogous art that would not be looked to for potential solutions in valuing an asset.

In addition, Applicants also respectfully submit that the Section 103 rejection of Claims 1-8, 10, 14, 16, 21, 22, 33-38, 40-43, 46, 49, 57, 64, 65, 66, and 67 is not a proper rejection. Obviousness cannot be established by merely suggesting that it would have been obvious to one of ordinary skill in the art to modify Eder using the teachings of Luchs. More specifically, as is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combinations. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants' disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion or motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

Neither Eder nor Luchs, considered alone or in combination, describe or suggest the combination(s) in Claims 1-8, 10, 14, 16, 21, 22, 33-38, 40-43, 46, 49, 57, 64, 65, 66, and 67.

Rather, the Section 103 rejection of Claims 1-8, 10, 14, 16, 21, 22, 33-38, 40-43, 46, 49, 57, 64, 65, 66, and 67 appears to be based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Specifically, Eder describes a system for measuring the performance of elements of a business enterprise and for valuing the elements on a specified valuation date wherein the performance of the elements is calculated using composite variables, and wherein predictive models are used to determine the correlation between the element performance and the enterprise value drivers, revenue, expenses, and changes in capital; and Luchs describes a computerized insurance system for processing and preparing applications for insurance and premium quotations and for preparing and writing insurance contracts.

The Office Action suggests at page 3 that the “motivation to combine these references is Eder’s valuation model is used to value businesses and equipment for insurance coverage purposes as well as to determine the equity prices...stock price of a business as a measure of value and risk is the appraisal that backs up the amount and type of insurance the company sells and the policy’s price.” Applicants respectfully submit that Eder provides no support for the statement that Eder’s valuation model is used to value businesses and equipment for insurance purposes. In fact, Eder does not even mention the word “insurance”. Rather, Eder is directed at valuing elements of a high technology commercial enterprise where a significant portion of the business value is associated with intangible assets (see col. 4, lines 15-18). Intangible assets are assets that are not typically covered by insurance. Accordingly, there is no motivation to combine Eder with Luchs.

Furthermore, Applicants respectfully traverse the suggestion that the stock price of a business is the appraisal that backs up the amount and type of insurance the business has and the price of the insurance policy. The stock price of a business does not necessarily reflect the type, amount, or cost of insurance maintained by the business. The Examiner has failed to provide any support showing otherwise.

Since there is no teaching nor suggestion for the combination of Eder and Luchs, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason also, Applicants request that the

Section 103 rejection of Claims 1-8, 10, 14, 16, 21, 22, 33-38, 40-43, 46, 49, 57, 64, 65, 66, and 67 be withdrawn.

For at least the reasons set forth above, Applicants respectfully request that the Section 103 rejection of Claims 1-8, 10, 14, 16, 21, 22, 33-38, 40-43, 46, 49, 57, 64, 65, 66, and 67 be withdrawn.

The rejection of Claims 17, 30-32, and 58-60 under 35 U.S.C. § 103(a) as being unpatentable over Eder and Luchs further in view of Cuomo et al. (U.S. Patent No. 6,185,614 B1) ("Cuomo") is respectfully traversed.

Eder and Luchs are both described above. Cuomo describes a system and method for collecting profile information about users accessing Web pages from a plurality of Web servers (see column 1, lines 7-12). In a specific embodiment of the system, a server dynamically generates a web page in response to a user request (see Abstract). The server then customizes the web page content based on the requested universal resource identifier and one or more of: the user's identity, access permissions, demographic information, and previous behavior at a site (see Abstract). The web server then passes the universal resource identifier, user identity, and dynamically generated web page to an access information collector which generates document comparators from the current web page content and compares them to document comparators associated with previously retrieved web pages (see Abstract). If the current web page is sufficiently similar to some previously retrieved web page, the access information collector logs the universal resource identifier, user identity, and a document key associated with the matching previously retrieved page (see Abstract). Otherwise, the access information collector generates a new key; stores the new key and the document comparators in a database; and logs the universal resource identifier, user identity, and the newly generated document key (see Abstract).

Claims 17 and 30-32 depend from independent Claim 1. Claim 1 is recited hereinabove.

None of Eder, Luchs, or Cuomo, considered alone or in combination, describe or suggest the method recited in Claim 1. More specifically, none of Eder, Luchs, or Cuomo, considered alone or in combination, describe or suggest a method for providing a value of a good to a requester that includes using a computer to determine whether the value of the good can be

calculated based on the uploaded data including determining whether the good has a policy value assigned thereto, designating the request for the value of the good as an exception request if no response is provided to the request for the value of the good, analyzing trends among a plurality of similar exception requests, and inputting at least one new policy value for a good based on the exception request analysis.

Rather, Eder describes a system for measuring the performance of elements of a business enterprise and for valuing the elements on a specified valuation date that includes using composite variables and predictive models; Luchs describes a computerized insurance system for processing and preparing applications for insurance and premium quotations and for preparing and writing insurance contracts; and Cuomo describes a server that dynamically generates a web page in response to a user request wherein the server customizes the web page content based on a requested universal resource identifier. Accordingly, Applicants respectfully submit that Claim 1 is patentable over Eder and Luchs further in view of Cuomo.

When the recitations of Claims 17 and 30-32 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 17 and 30-32 likewise are patentable over Eder and Luchs further in view of Cuomo.

Claims 58-60 depend from independent Claim 34. Claim 34 is recited hereinabove.

None of Eder, Luchs, or Cuomo, considered alone or in combination, describe or suggest the system recited in Claim 34. More specifically, none of Eder, Luchs, or Cuomo, considered alone or in combination, describe or suggest a system for providing a value of a good to a requester that includes a server that is configured to determine whether the value of the good can be calculated based on the inputted data including determining whether the good has a policy value assigned thereto, recognize the request for the value of the good as an exception request if no response is provided by the system to the request for the value of the good, analyze trends among a plurality of similar exception requests, and receive at least one new policy value for a good based on the exception request analysis.

Rather, Eder describes a system for measuring the performance of elements of a business enterprise and for valuing the elements on a specified valuation date that includes using

composite variables and predictive models; Luchs describes a computerized insurance system for processing and preparing applications for insurance and premium quotations and for preparing and writing insurance contracts; and Cuomo describes a server that dynamically generates a web page in response to a user's request and the server customizes the web page content based on the requested universal resource identifier. Accordingly, Applicants respectfully submit that Claim 34 is patentable over Eder and Luchs further in view of Cuomo.

When the recitations of Claims 58-60 are considered in combination with the recitations of Claim 34, Applicants submit that dependent Claims 58-60 likewise are patentable over Eder and Luchs further in view of Cuomo.

The rejection of Claims 19-20 and 62-63 under 35 U.S.C. § 103(a) as being unpatentable over Eder and Luchs further in view of Lange (U.S. Patent No. 6,321,212 B1) is respectfully traversed.

Eder and Luchs are both described above. Lange describes systems and methods for trading and investing in groups of demand-based adjustable-return contingent claims, and for establishing markets and exchanges for such claims (see Abstract). The claims are contingent in that their payout or return depends on the outcome of an observable event of economical significance with more than one possible outcome (see column 6, lines 52-55, see column 113, lines 5-7). Examples of contingent claims include stocks, bonds, and other such securities (see column 7, lines 34-36). A state corresponds to at least one possible outcome of the event (see column 113, lines 5-7). In one embodiment, a payout matrix is a total amount invested less a transaction fee, multiplied by a diagonal matrix which contains an inverse of the total amount invested in each state along the diagonal, respectively, and zeros elsewhere (see column 27, lines 1-32).

Claims 19 and 20 depend from independent Claim 1. Claim 1 is recited hereinabove.

None of Eder, Luchs, or Lange, considered alone or in combination, describe or suggest the method recited in Claim 1. More specifically, none of Eder, Luchs, or Lange, considered alone or in combination, describe or suggest a method for providing a value of a good to a requester that includes using a computer to determine whether the value of the good can be

calculated based on the uploaded data including determining whether the good has a policy value assigned thereto, designating the request for the value of the good as an exception request if no response is provided to the request for the value of the good, analyzing trends among a plurality of similar exception requests, and inputting at least one new policy value for a good based on the exception request analysis.

Rather, Eder describes a system for measuring the performance of elements of a business enterprise and for valuing the elements on a specified valuation date that includes using composite variables and predictive models; Luchs describes a computerized insurance system for processing and preparing applications for insurance and premium quotations and for preparing and writing insurance contracts; and Lange describes a system for trading and investing in groups of demand-based adjustable-return contingent claims. Accordingly, Applicants respectfully submit that Claim 1 is patentable over Eder and Luchs further in view of Lange.

When the recitations of Claims 19 and 20 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 19 and 20 likewise are patentable over Eder and Luchs further in view of Lange.

Claims 62 and 63 depend from independent Claim 34. Claim 34 is recited hereinabove.

None of Eder, Luchs, or Lange, considered alone or in combination, describe or suggest the system recited in Claim 34. More specifically, none of Eder, Luchs, or Lange, considered alone or in combination, describe or suggest a system for providing a value of a good to a requester that includes a server that is configured to determine whether the value of the good can be calculated based on the inputted data including determining whether the good has a policy value assigned thereto, recognize the request for the value of the good as an exception request if no response is provided by the system to the request for the value of the good, analyze trends among a plurality of similar exception requests, and receive at least one new policy value for a good based on the exception request analysis.

Rather, Eder describes a system for measuring the performance of elements of a business enterprise and for valuing the elements on a specified valuation date that includes using composite variables and predictive models; Luchs describes a computerized insurance system for

processing and preparing applications for insurance and premium quotations and for preparing and writing insurance contracts; and Lange describes a system for trading and investing in groups of demand-based adjustable-return contingent claims. Accordingly, Applicants respectfully submit that Claim 34 is patentable over Eder and Luchs further in view of Lange.

When the recitations of Claims 62 and 63 are considered in combination with the recitations of Claim 34, Applicants submit that dependent Claims 62 and 63 likewise are patentable over Eder and Luchs further in view of Lange.

The rejection of Claims 15 and 39 under 35 U.S.C. § 103(a) as being unpatentable over Eder and Luchs further in view of Eder (U.S. Patent No. 6,321,205 B1) ("Eder-1") is respectfully traversed.

Eder and Luchs are both described above. Eder-1 describes an automated system and method for evaluating probable impact of user-specified or system generated changes in business value drivers on other value drivers, financial performance and future value of a commercial enterprise (see Abstract). Value drivers are associated with each element of value of the enterprise (see Abstract). An element of value is defined as "an identifiable entity or group that as a result of past transactions has provided and is expected to provide economic benefit to the enterprise (see column 11, lines 38-43). An example of an element of value is a sales staff of the enterprise (see column 11, lines 44-46). A calculated value of production equipment element of value is compared to a liquidation value for the equipment in the element (see column 43, lines 51-54). The stored value for the element will be the higher of the liquidation value or calculated value (see column 43, lines 54-56).

Claim 15 depends from independent Claim 1. Claim 1 is recited hereinabove.

None of Eder, Luchs, or Eder-1, considered alone or in combination, describe or suggest the method recited in Claim 1. More specifically, none of Eder, Luchs, or Eder-1, considered alone or in combination, describe or suggest a method for providing a value of a good to a requester that includes using a computer to determine whether the value of the good can be calculated based on the uploaded data including determining whether the good has a policy value assigned thereto, designating the request for the value of the good as an exception request if no

response is provided to the request for the value of the good, analyzing trends among a plurality of similar exception requests, and inputting at least one new policy value for a good based on the exception request analysis.

Rather, Eder describes a system for measuring the performance of elements of a business enterprise and for valuing the elements on a specified valuation date that includes using composite variables and predictive models; Luchs describes a computerized insurance system for processing and preparing applications for insurance and premium quotations and for preparing and writing insurance contracts; and Eder-1 describes a calculated value of production equipment element of value that is compared to a liquidation value for the equipment in the element and a stored value for the element will be the higher of the liquidation value or calculated value. Accordingly, Applicants respectfully submit that Claim 1 is patentable over Eder and Luchs further in view of Eder-1.

When the recitations of Claim 15 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claim 15 likewise is patentable over Eder and Luchs further in view of Eder-1.

Claim 39 depends from independent Claim 34. Claim 34 is recited hereinabove.

None of Eder, Luchs, or Eder-1, considered alone or in combination, describe or suggest the system recited in Claim 34. More specifically, none of Eder, Luchs, or Eder-1, considered alone or in combination, describe or suggest a system for providing a value of a good to a requester that includes a server that is configured to determine whether the value of the good can be calculated based on the inputted data including determining whether the good has a policy value assigned thereto, recognize the request for the value of the good as an exception request if no response is provided by the system to the request for the value of the good, analyze trends among a plurality of similar exception requests, and receive at least one new policy value for a good based on the exception request analysis.

Rather, Eder describes a system for measuring the performance of elements of a business enterprise and for valuing the elements on a specified valuation date that includes using composite variables and predictive models; Luchs describes a computerized insurance system for

processing and preparing applications for insurance and premium quotations and for preparing and writing insurance contracts; and Eder-1 describes a calculated value of production equipment element of value that is compared to a liquidation value for the equipment in the element and a stored value for the element will be the higher of the liquidation value or calculated value. Accordingly, Applicants respectfully submit that Claim 34 is patentable over Eder and Luchs further in view of Eder-1.

When the recitations of Claim 39 are considered in combination with the recitations of Claim 34, Applicants submit that dependent Claim 39 likewise are patentable over Eder and Luchs further in view of Eder-1.

The rejection of Claims 18, 23-25, 29, 53-56, and 61 under 35 U.S.C. § 103(a) as being unpatentable over Eder and Luchs further in view of Borghesi et al. (U.S. Patent No. 5,950,169) (“Borghesi”) is respectfully traversed.

Eder and Luchs are both described above. Borghesi describes a system and method for managing insurance claims work flow (see column 1, lines 24-26). The system has a total loss information tab that contains information on total loss valuation such as general vehicle by year, model, etc. (see column 10, lines 5-8). A user has an option to request a more complete total loss valuation by transmitting a request for a valuation to a provider and transmitting a copy of a pertinent vehicle information with the request (see column 10, lines 7-12). The total loss value is an estimated value assigned to a damaged vehicle to generally determine if the cost to repair exceeds the total value of the vehicle (see column 10, lines 11-14). Typically, if an estimate to repair exceeded the estimated total loss value, then the insurance company usually gives the insured a money settlement and the car is salvaged (see column 10, lines 13-18). The settlement value may be a percentage of the total loss, due to a price of selling the total vehicle to a salvage parts dealer (see column 10, lines 17-19). If the total loss value were greater than an estimate of the repair, then a decision may be to repair a damaged vehicle (see column 10, lines 18-22). Thus, the total loss value is used to help determine whether a repair shop gets a job, or whether an owner of a vehicle gets a dollar settlement value for the vehicle (see column 10, lines 21-24).

Claims 18, 23-25, and 29 depend from independent Claim 1. Claim 1 is recited hereinabove.

None of Eder, Luchs, or Borghesi, considered alone or in combination, describe or suggest the method recited in Claim 1. More specifically, none of Eder, Luchs, or Borghesi, considered alone or in combination, describe or suggest a method for providing a value of a good to a requester that includes using a computer to determine whether the value of the good can be calculated based on the uploaded data including determining whether the good has a policy value assigned thereto, designating the request for the value of the good as an exception request if no response is provided to the request for the value of the good, analyzing trends among a plurality of similar exception requests, and inputting at least one new policy value for a good based on the exception request analysis.

Rather, Eder describes a system for measuring the performance of elements of a business enterprise and for valuing the elements on a specified valuation date that includes using composite variables and predictive models; Luchs describes a computerized insurance system for processing and preparing applications for insurance and premium quotations and for preparing and writing insurance contracts; and Borghesi describes a system for managing insurance claims work flow that enables a user to request a more complete total loss valuation of a vehicle by transmitting a request for the valuation along with a copy of the pertinent vehicle information to a provider. Accordingly, Applicants respectfully submit that Claim 1 is patentable over Eder and Luchs further in view of Borghesi.

When the recitations of Claims 18, 23-25, and 29 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 18, 23-25, and 29 likewise are patentable over Eder and Luchs further in view of Borghesi.

Claims 53-56, and 61 depend from independent Claim 34. Claim 34 is recited hereinabove.

None of Eder, Luchs, or Borghesi, considered alone or in combination, describe or suggest the system recited in Claim 34. More specifically, none of Eder, Luchs, or Borghesi, considered alone or in combination, describe or suggest a system for providing a value of a good

to a requester that includes a server that is configured to determine whether the value of the good can be calculated based on the inputted data including determining whether the good has a policy value assigned thereto, recognize the request for the value of the good as an exception request if no response is provided by the system to the request for the value of the good, analyze trends among a plurality of similar exception requests, and receive at least one new policy value for a good based on the exception request analysis.

Rather, Eder describes a system for measuring the performance of elements of a business enterprise and for valuing the elements on a specified valuation date that includes using composite variables and predictive models; Luchs describes a computerized insurance system for processing and preparing applications for insurance and premium quotations and for preparing and writing insurance contracts; and Borghesi describes a system for managing insurance claims work flow that enables a user to request a more complete total loss valuation of a vehicle by transmitting a request for the valuation along with a copy of the pertinent vehicle information to a provider. Accordingly, Applicants respectfully submit that Claim 34 is patentable over Eder and Luchs further in view of Borghesi.

When the recitations of Claims 53-56, and 61 are considered in combination with the recitations of Claim 34, Applicants submit that dependent Claims 53-56, and 61 likewise are patentable over Eder and Luchs further in view of Borghesi.

The rejection of Claims 26-28 and 50-52 under 35 U.S.C. § 103(a) as being unpatentable over Eder and Luchs further in view of Donald E. Kieso & Jerry J. Weygandt, *Intermediate Accounting*, John Wiley & Sons, 1989, Chapter 22, pages 1190-1227 ("Kieso") is respectfully traversed.

Eder and Luchs are both described above. Kieso describes accounting issues relating to leasing (see page 1190). One of the issues discussed is that of residual values (see page 1209). The residual value is an estimated fair value of a leased asset at the end of a lease term (see page 1209). The residual value may be guaranteed or unguaranteed by a lessee (see page 1209). If the lessee agrees to make up any deficiency below a stated amount that a lessor realizes in

residual value at the end of the lease term, that stated amount is the guaranteed residual value (see page 1209).

Claims 26-28 depend from independent Claim 1. Claim 1 is recited hereinabove.

None of Eder, Luchs, or Kieso, considered alone or in combination, describe or suggest the method recited in Claim 1. More specifically, none of Eder, Luchs, or Kieso, considered alone or in combination, describe or suggest a method for providing a value of a good to a requester that includes using a computer to determine whether the value of the good can be calculated based on the uploaded data including determining whether the good has a policy value assigned thereto, designating the request for the value of the good as an exception request if no response is provided to the request for the value of the good, analyzing trends among a plurality of similar exception requests, and inputting at least one new policy value for a good based on the exception request analysis.

Rather, Eder describes a system for measuring the performance of elements of a business enterprise and for valuing the elements on a specified valuation date that includes using composite variables and predictive models; Luchs describes a computerized insurance system for processing and preparing applications for insurance and premium quotations and for preparing and writing insurance contracts; and Kieso generally describes accounting issues that relate to leasing including residual values. Accordingly, Applicants respectfully submit that Claim 1 is patentable over Eder and Luchs further in view of Kieso.

When the recitations of Claims 26-28 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 26-28 likewise are patentable over Eder and Luchs further in view of Kieso.

Claims 50-52 depend from independent Claim 34. Claim 34 is recited hereinabove.

None of Eder, Luchs, or Kieso, considered alone or in combination, describe or suggest the system recited in Claim 34. More specifically, none of Eder, Luchs, or Kieso, considered alone or in combination, describe or suggest a system for providing a value of a good to a requester that includes a server that is configured to determine whether the value of the good can

be calculated based on the inputted data including determining whether the good has a policy value assigned thereto, recognize the request for the value of the good as an exception request if no response is provided by the system to the request for the value of the good, analyze trends among a plurality of similar exception requests, and receive at least one new policy value for a good based on the exception request analysis.

Rather, Eder describes a system for measuring the performance of elements of a business enterprise and for valuing the elements on a specified valuation date that includes using composite variables and predictive models; Luchs describes a computerized insurance system for processing and preparing applications for insurance and premium quotations and for preparing and writing insurance contracts; and Kieso generally describes accounting issues that relate to leasing including residual values. Accordingly, Applicants respectfully submit that Claim 34 is patentable over Eder and Luchs further in view of Kieso.

When the recitations of Claims 50-52 are considered in combination with the recitations of Claim 34, Applicants submit that dependent Claims 50-52 likewise are patentable over Eder and Luchs further in view of Kieso.

The rejection of Claims 11-13, 45, 47, and 48 under 35 U.S.C. § 103(a) as being unpatentable over Eder and Luchs, and further in view of Borghesi and Baker et al. (U.S. Patent No. 6,405,204 B1) ("Baker") is respectfully traversed.

Eder, Luchs, and Borghesi are all described above. Baker describes an alerts system that provides index performance alerts by sector. The index alerts are based on price performance measures of each industry, sector, sub-sector, or group, referred to collectively as "sector". Users are able to define limits for the industry, sector, sub-sector, or group categories for alerts on price, volume, intraday range, current closing price relative to the intraday range, price to revenues, price to earnings, price to book value, and price to cash flow. Users have the ability to define at least one area in a hierarchy of industry, sector, sub-sector, or group levels, for setting alerts. The invention also provides news alerts for a user selected hierarchy level and/or an individual ticker symbol. Users are alerted when a news story, linked to a user-specified group or ticker, is created. The invention uses a proprietary product/service hierarchy methodology for

categorization of companies, wherein the categorization methodology automatically extends the functionality to deliver a plurality of other alert notifications associated with subsidiary classifications, constituent companies' classifications, or to securities instruments (see Abstract).

Claims 11-13 depend from independent Claim 1. Claim 1 is recited hereinabove.

None of Eder, Luchs, Borghesi, or Baker, considered alone or in combination, describe or suggest the method recited in Claim 1. More specifically, none of Eder, Luchs, Borghesi, or Baker, considered alone or in combination, describe or suggest a method for providing a value of a good to a requester that includes using a computer to determine whether the value of the good can be calculated based on the uploaded data including determining whether the good has a policy value assigned thereto, designating the request for the value of the good as an exception request if no response is provided to the request for the value of the good, analyzing trends among a plurality of similar exception requests, and inputting at least one new policy value for a good based on the exception request analysis.

Rather, Eder describes a system for measuring the performance of elements of a business enterprise and for valuing the elements on a specified valuation date that includes using composite variables and predictive models; Luchs describes a computerized insurance system for processing and preparing applications for insurance and premium quotations and for preparing and writing insurance contracts; Borghesi describes a system for managing insurance claims work flow that enables a user to request a more complete total loss valuation of a vehicle by transmitting a request for the valuation along with a copy of the pertinent vehicle information to a provider; and Baker describes an alerts system for providing index performance alerts that are based on price performance measures of each industry, sector, sub-sector, or group. Accordingly, Applicants respectfully submit that Claim 1 is patentable over Eder and Luchs further in view of Borghesi and Baker.

When the recitations of Claims 11-13 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 11-13 likewise are patentable over Eder and Luchs further in view of Borghesi and Baker.

Claims 45, 47, and 48 depend from independent Claim 34. Claim 34 is recited hereinabove.

None of Eder, Luchs, Borghesi, or Baker, considered alone or in combination, describe or suggest the system recited in Claim 34. More specifically, none of Eder, Luchs, Borghesi, or Baker, considered alone or in combination, describe or suggest a system for providing a value of a good to a requester that includes a server that is configured to determine whether the value of the good can be calculated based on the inputted data including determining whether the good has a policy value assigned thereto, recognize the request for the value of the good as an exception request if no response is provided by the system to the request for the value of the good, analyze trends among a plurality of similar exception requests, and receive at least one new policy value for a good based on the exception request analysis.

Rather, Eder describes a system for measuring the performance of elements of a business enterprise and for valuing the elements on a specified valuation date that includes using composite variables and predictive models; Luchs describes a computerized insurance system for processing and preparing applications for insurance and premium quotations and for preparing and writing insurance contracts; Borghesi describes a system for managing insurance claims work flow that enables a user to request a more complete total loss valuation of a vehicle by transmitting a request for the valuation along with a copy of the pertinent vehicle information to a provider; and Baker describes an alerts system for providing index performance alerts that are based on price performance measures of each industry, sector, sub-sector, or group. Accordingly, Applicants respectfully submit that Claim 34 is patentable over Eder and Luchs further in view of Borghesi and Baker.

When the recitations of Claims 45, 47, and 48 are considered in combination with the recitations of Claim 34, Applicants submit that dependent Claims 45, 47, and 48 likewise are patentable over Eder and Luchs further in view of Borghesi and Baker.

In addition to the arguments set forth above, Applicants also respectfully submit that the Section 103 rejections of the presently pending claims are not proper rejections. Obviousness cannot be established by merely suggesting that it would have been obvious to one of ordinary

skill in the art to modify Eder and Luchs using the teachings of Cuomo, to modify Eder and Luchs using the teachings of Lange, to modify Eder and Luchs using the teachings of Eder-1, to modify Eder and Luchs using the teachings of Borghesi, to modify Eder and Luchs using the teachings of Kieso, and to modify Eder and Luchs using the teachings of Borghesi and Baker. More specifically, as is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combinations. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levensgood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants' disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion or motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

None of Eder, Luchs, or Cuomo, considered alone or in combination, describe or suggest the combination(s) in Claims 17, 30-32, and 58-60. Rather, the Section 103 rejection of Claims 17, 30-32, and 58-60 appears to be based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Specifically, Eder describes a system for measuring the performance of elements of a business enterprise and for valuing the elements on a specified valuation date wherein the performance of the elements is calculated using composite variables, and wherein predictive models are used to determine the correlation between the element performance and the enterprise value drivers, revenue, expenses, and changes in capital; Luchs describes a computerized insurance system for processing and preparing applications for

insurance and premium quotations and for preparing and writing insurance contracts; and Cuomo describes a server that dynamically generates a web page in response to a user request, wherein the server customizes the web page content based on a requested universal resource identifier. Since there is no teaching nor suggestion for the combination of Eder, Luchs, and Cuomo, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason also, Applicants request that the Section 103 rejection of Claims 17, 30-32, and 58-60 be withdrawn.

Moreover, none of Eder, Luchs, or Lange, considered alone or in combination, describe or suggest the combination(s) in Claims 19, 20, 62, and 63. Rather, the Section 103 rejection of Claims 19, 20, 62, and 63 appears to be based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Specifically, Eder describes a system for measuring the performance of elements of a business enterprise and for valuing the elements on a specified valuation date, wherein the performance of the elements is calculated using composite variables, and wherein predictive models are used to determine the correlation between the element performance and the enterprise value drivers, revenue, expenses, and changes in capital; Luchs describes a computerized insurance system for processing and preparing applications for insurance and premium quotations and for preparing and writing insurance contracts; and Lange describes a payout matrix is a total amount invested less a transaction fee, multiplied by a diagonal matrix which contains an inverse of the total amount invested in each state along the diagonal, respectively, and zeros elsewhere. Since there is no teaching nor suggestion for the combination of Eder, Luchs, and Lange, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason also, Applicants request that the Section 103 rejection of Claims 19, 20, 62, and 63 be withdrawn.

Furthermore, none of Eder, Luchs, or Eder-1, considered alone or in combination, describe or suggest the combination(s) in Claims 15 and 39. Rather, the Section 103 rejection of 15 and 39 appears to be based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Specifically, Eder describes a system for measuring

the performance of elements of a business enterprise and for valuing the elements on a specified valuation date, wherein the performance of the elements is calculated using composite variables, and wherein predictive models are used to determine the correlation between the element performance and the enterprise value drivers, revenue, expenses, and changes in capital; Luchs describes a computerized insurance system for processing and preparing applications for insurance and premium quotations and for preparing and writing insurance contracts; and Eder-1 describes that in a sixth stage, a calculated value of production equipment element of value is compared to a liquidation value for the equipment in the element and a stored value for the element will be the higher of the liquidation value or calculated value. Since there is no teaching nor suggestion for the combination of Eder, Luchs, and Eder-1, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason also, Applicants request that the Section 103 rejection of Claims 15 and 39 be withdrawn.

Additionally, none of Eder, Luchs, or Borghesi, considered alone or in combination, describe or suggest the combination(s) in Claims 18, 23-25, 29, 53-56, and 61. Rather, the Section 103 rejection of 18, 23-25, 29, 53-56, and 61 appears to be based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Specifically, Eder describes a system for measuring the performance of elements of a business enterprise and for valuing the elements on a specified valuation date, wherein the performance of the elements is calculated using composite variables, and wherein predictive models are used to determine the correlation between the element performance and the enterprise value drivers, revenue, expenses, and changes in capital; Luchs describes a computerized insurance system for processing and preparing applications for insurance and premium quotations and for preparing and writing insurance contracts; and Borghesi describes that a user has an option to request a more complete total loss valuation by transmitting the request for the valuation to a provider and transmitting a copy of a pertinent vehicle information with the request. Since there is no teaching nor suggestion for the combination of Eder, Luchs, and Borghesi, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a

combination is impermissible, and for this reason also, Applicants request that the Section 103 rejection of Claims 18, 23-25, 29, 53-56, and 61 be withdrawn.

Moreover, none of Eder, Luchs, or Kieso, considered alone or in combination, describe or suggest the combination(s) in Claims 26-28 and 50-52. Rather, the Section 103 rejection 26-28 and 50-52 appears to be based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Specifically, Eder describes a system for measuring the performance of elements of a business enterprise and for valuing the elements on a specified valuation date, wherein the performance of the elements is calculated using composite variables, and wherein predictive models are used to determine the correlation between the element performance and the enterprise value drivers, revenue, expenses, and changes in capital; Luchs describes a computerized insurance system for processing and preparing applications for insurance and premium quotations and for preparing and writing insurance contracts; and Kieso describes that whether a residual value is guaranteed or unguaranteed, lessor's amount to be recovered through lease rentals is the same. Since there is no teaching nor suggestion for the combination of Eder, Luchs, and Kieso, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason also, Applicants request that the Section 103 rejection of Claims 26-28 and 50-52 be withdrawn.

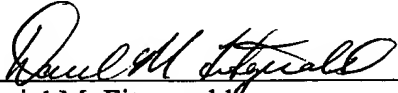
Furthermore, none of Eder, Luchs, Borghesi, or Baker, considered alone or in combination, describe or suggest the combination(s) in Claims 11-13, 45, 47, and 48. Rather, the present Section 103 rejection appears to be based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Specifically, Eder describes a system for measuring the performance of elements of a business enterprise and for valuing the elements on a specified valuation date, wherein the performance of the elements is calculated using composite variables, and wherein predictive models are used to determine the correlation between the element performance and the enterprise value drivers, revenue, expenses, and changes in capital; Luchs describes a computerized insurance system for processing and preparing applications for insurance and premium quotations and for preparing and writing insurance contracts; Borghesi describes that a user has an option to request a more complete total

loss valuation by transmitting the request for the valuation to a provider and transmitting a copy of a pertinent vehicle information with the request; and Baker describes that users are alerted when a news story, linked to a user-specified group or ticker, is created and that a categorization methodology automatically extends a functionality to deliver a plurality of other alert notifications associated with subsidiary classifications, constituent companies' classifications, or to securities instruments. Since there is no teaching nor suggestion for the combination of Eder, Luchs, Borghesi, and Baker, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason also, Applicants request that the Section 103 rejection of Claims 11-13, 45, 47, and 48 be withdrawn.

For at least the reasons set for above, Applicants respectfully request that the Section 103 rejection of Claims 17, 30-32. and 58-60; the rejection of Claims 19-20 and 62-63; the rejection of Claims 15 and 39; the rejection of Claims 18, 23-25, 29, 53-56, and 61; the rejection of Claims 26-28 and 50-52; and the rejection of Claims 11-13, 45, 47, and 48 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



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